

REMARKS

By the response, claim 59 is revised to place this application in condition for allowance. Currently, claims 59-75 are before the Examiner for consideration on their merits.

In the Action, the Examiner indicated that claim 60 contained allowable subject matter. Since Applicants believe that the broader patent protection should be granted than that specifically set out in claim 60, claim 59 is revised in a slightly different manner than by incorporating the limitations of claim 60 therein. However and as detailed below, the cited prior art does not teach or suggest the features of claim 59, as amended, and a *prima facie* case of obviousness does not exist with respect to this claim.

In review, the Examiner has rejected claim 59 based on United States Published Patent Application No. 2004/0194893 to Shirakura. Shirakura teaches a process wherein cut out pieces of recording medium are laminated by heating and pressure bonding a protective film onto both sides of the piece for protecting both sides of the cut out pieces of recording medium. Specifically, Shirakura only discloses a so-called laminating pouch, in which by thermally pressure bonding the outer periphery of the plastic film with sandwiching each cut out piece of recording medium with the plastic film through the both sides of the cut pieces, the cut out pieces of recording medium are sealed within the plastic film to protect both sides of the cut out pieces of the recording film.

Comparing the teachings of Shirakura to claim 59, as amended, reveals that the Shirakura does not teach all of the claimed features. Claim 59 is drawn to the invention for forming a laminate layer on a recording surface of a recording medium by the steps of

laying a laminate material having a size larger than the recording medium over the same and thermally press bonding them together. In addition, claim 59 requires transferring the laminate layer protruding outwards from the recording medium onto a transfer medium means that is disposed on the side of the surface of the recording medium opposite the recording surface.

Claim 59 further defines that by moving the transfer medium away from the surface of the recording medium opposite to the recording surface, it becomes possible to enable the laminate layer to be separated into a laminated portion formed on the recording surface of the recording medium and a non-laminated portions protruding outward from the recording medium and transferred onto the transfer medium means.

While it can be said that the laminate layer of claim 59 would correspond to the plastic film of Shirakura, this is where the similarity between claim 59 and Shirakura ends. The plastic film of Shirakura is not expected to be separated into a laminated portion and a non-laminated portion. Moreover, such separation would not even be possible according to the structure of Shirakura. Since Shirakura does not teach this feature of claim 59, a *prima facie* case of obviousness cannot be said to exist against this claim and the rejection based on Shirakura should be withdrawn.

Further, since claim 59, as amended, is patentable over Shirakura, its dependent claims are also in condition for allowance.

Accordingly, the Examiner is requested to examine this application in light of this amendment and pass all pending claims onto issuance.

If the Examiner believes that an interview would be helpful in expediting the allowance of this application, the Examiner is requested to telephone the undersigned

Serial No.: 10/594,726

at 202-835-1753.

Again, reconsideration and allowance of this application is respectfully requested.

The above constitutes a complete response to all issues raised in the Office
Action dated August 21, 2009.

Applicants respectfully submit that no fee is required in connection with this filing
but any fee deficiencies should be charged to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in cursive script, appearing to read "Christopher W. Brody", written over a horizontal line.

Christopher W. Brody
Registration No. 33,613

Customer No. 22902

1090 Vermont Avenue, NW, Suite 250
Washington, DC 20005
Telephone: 202-835-1753
Facsimile: 202-835-1755

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